

**REMARKS/ARGUMENTS**

Upon entry of this amendment, claims 1-29 will be pending in this application and presented for examination. Claims 1, 14, 28, and 29 were amended. Support for the amended claims can be found in the specification. No new matter has been added. Reconsideration is respectfully requested.

**Claim Rejections under 35 U.S.C. § 101**

Claims 1-29 were rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner stated that "[a]lthough the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is **not within the technological arts** as explained above, claims 1-29 are deemed to be directed to non-statutory subject matter." Office Action mailed October 3, 2005, page 4, emphasis added.

Applicants respectfully traverse all the Examiner's rejections. U.S. Patent and Trademark Office Board of Patent Appeals and Interferences has held that "[o]ur determination is that there is currently **no judicially recognized separate 'technological arts' test** to determine patent eligible subject matter under § 101. We decline to create one." See Ex Parte Carl A. Lundgren, 76 U.S.P.Q.2d 1385, 1388 (Bd. Pat. App. & Interf. 2004) (emphasis added). Accordingly, the rejections of claims 1-29 under 35 U.S.C. § 101 should be withdrawn for at least above reasons.

Additionally, the Examiner appears to have made an erroneous reference to "an insurance policy." Office Action mailed October 3, 2005, page 3, line 7. Certain embodiments of the present invention relate to a computerized ordering system, which, with respect, Applicants do not believe could be reproduced by thinking about the matter and use of a pen and paper. For example, the master list could be written down on a piece of paper, as could all the contact details of the suppliers. Nevertheless, Applicants consider that the amount of paper required to make the comparison for each product on the master list, with every supplier, and compare every price, and all the product terms (such as number of products purchased,

availability, payment terms, discounts etc.), would use a considerable amount of paper, and in addition the task would be extremely time consuming according to an embodiment of the present invention. Further, since the prices, terms and availability of the products on the master list would be changing frequently, it may be that it would not be possible to complete calculations before changes were made, invalidating the prior results according to another embodiment of the present invention.

Nevertheless, to assist the Examiner to allow the present application, Applicants have requested amendments to claims 1, 14, 28 and 29 to make clear that these claims each recite a network and a database or database storage means, which evidently could not be recreated simply using a brain and a piece of paper and a pen. The support for these amendments can be found at least at Specification, page 8, lines 14-15 and 19.

### **Claim Rejections under 35 U.S.C. § 103**

Claims 1-27 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Erickson in view of U.S. Patent No. 5,758,328 (Giovannoli). Applicants respectfully traverse all the Examiner's rejections.

Erickson appears to disclose a method of enabling a potential purchaser to broadcast a request for bids for a particular product or service, to have the broadcast sent to a database of suppliers and to track and store the responses from the suppliers. As stated at column 3, lines 43-51, if a purchaser wishes to purchase goods or services, the purchaser browses the database to assemble a list of suppliers to which the request for bids is to be broadcast. This appears to be essentially the same as a potential buyer browsing, for example, the electronic Yellow Pages for suitable suppliers and earmarking some of them for receipt of the broadcast. Once the responses have been received, the buyer needs to trawl through them to decide on the most appropriate bid.

It is notable that Erickson's method does not appear to match buyers and sellers and does not appear to have any mechanism for determining the best available price. The buyer is obliged to spend significant time in selecting the potential suppliers and in assessing the bids and deciding which one to accept. Basically, the disclosure in Erickson appears to fit into the

description under the heading "Background Art" in the present application on page 1, lines 10-25.

There does not appear to be any disclosure in the Examiner's citation for storage of a master list of items, each of the items representing a product or service. On the contrary, information as to products or services is submitted by each particular vendor, along with company profiles etc. See Erickson, column 3, lines 13-25. While the product lines may be grouped into various classifications, this is not the same as providing a master list of items.

Certain embodiments of the present invention requires the storing of item sales terms, such as stock levels, freight charges, geographic limitations on supply. Specification, page 4, lines 12-14. There does not appear to be disclosure of this in Erickson.

Some embodiments of the present invention provide the process of extracting an available item sublist from the master list, based on item selection criteria. This is, for example, carried out as part of the computerized method, and extraction means are provided in the system according to an embodiment of the invention. In the case of Erickson, it appears to be the buyer which needs to construct a sublist from the data entered by vendors. Hence there does not appear to be a master list.

Additionally, certain embodiments of the present invention also provide selection means to select suppliers, based on certain criteria. In the case of Erickson, the purchaser is obliged to spend considerable time in deciding which suppliers or vendors to which the buyer should send the datacast message. Erickson, column 3, lines 52-55.

Referring in detail to the Examiner's analysis, although Erickson may include storage means for storing the information supplied by the vendors and the datacast message sent by the buyer, together with the responses, Erickson does not disclose a master list of items, each item representing a product or service. On the contrary, column 3, lines 12-15 of Erickson refers to the vendor entering information as to the vendor's products or services. There does not appear to be any disclosure of any master list. It appears to be necessary to extract information from the vendor's submission in each case. While these may be grouped into various classifications, this is within each vendor's submission. Erickson, column 3, lines 19-23. Moreover, Erickson

reinforces this: "... central database 16 may contain ... information regarding products ... **offered by a particular supplier.**" Erickson, column 7, lines 11-14, emphasis added.

The Examiner asserted that Erickson discloses storage means for storing item sales terms for at least one of the items for at least one of the suppliers and refers to column 7, lines 11-14 of Erickson. It is noted that the Examiner interprets "information" to include item sales terms. With respect, the passage refers to by the Examiner does not appear to contain any hint of any information relating to item sales terms. The passage is in very general terms. The Examiner's assertion is not supported by the disclosure in Erickson.

Additionally, the Examiner asserted that purchaser terms for at least one of the purchasers for at least one of the suppliers is disclosed in Erickson and refers to column 8, lines 4-11. Again, with respect, there does not appear to be any hint in the passage noted by the Examiner of any purchaser terms of the type referred to in certain embodiments of the present application. Rather, the information referred to is limited to company profiles containing information about the company or classifications of goods or services that are routinely purchased or desired by a particular buyer.

Moreover, the Examiner stated that Erickson discloses item selection criteria generating means for generating item selection criteria in column 8, lines 28-32 of Erickson. Claim 1 of the present application requires that each item represents a product or service. The passage referred to by the Examiner appears to describe the assembly of a list of **suppliers** of interest from a central database which the buyer has browsed. There does not appear to be any disclosure of any means for generating **item** selection criteria. To use the system in Erickson, a buyer would need to carry out a good deal of work in order to have any hope of identifying items by any type of criteria. From a reading of Erickson, it is likely that a buyer would not be able to identify many relevant items, because the vendor may not have provided sufficient information for selection by criteria. Further, there does not appear to any disclosure of any facility for inputting criteria to select items. All that Erickson discloses appear to be the possibility of having items grouped into various classifications in order to help purchasers locate suppliers of a particular type or class of goods of service. Erickson, column 3, lines 19-22. In any event, the

system of Erickson does not contain any item selection criteria generating means as recited in one or more pending claims.

Also, the Examiner stated that Erickson discloses extraction means for extracting an item sub-list from the master list based on the generated item selection criteria and refers to column 8, lines 31-32 of Erickson. As submitted above, there does not appear to be any disclosure of any master list of items (products or services) in Erickson. Further, there does not appear to be any disclosure of any extraction means for extracting a sub-list. The passage referred to by the Examiner simply discloses what happens when a buyer browses the central database and assembles a list of suppliers of interest. The buyer does not represent "extraction means". In addition, what the buyer assembles is a list of suppliers of interest, not a list of items. Applicants note that the Examiner interprets "assemble list" to include extracting an item sublist from the master list. However, with respect, this does not appear to have been disclosed in Erickson.

Because the system of Erickson may be conducted using the internet, presumably display means can be involved to display the list of suppliers of interest which has been assembled by the buyer, but these are not specifically disclosed. Additionally, for certain embodiments of the present invention, the display means displays the item sub-list extracted by the extracting means from the master list.

In relation to the input means, the Examiner referred to column 13, lines 66-67 and column 14, lines 1-15 of Erickson. The passages referred to by the Examiner appear to allow a buyer to enter a sequence of prompts in the datacast, so that the prompted areas will be displayed to a supplier and the supplier can complete these when submitting the supplier's bid. What happens after that is that the buyer assesses all the bids and decides which one or ones to accept. In contrast, the input means according to some embodiments of the present invention automatically selects desired items from the item sub-list and specifies desired quantities of them. For example, the buyer is not required to trawl through the bids and make a decision. Rather, the buyer is automatically matched with suitable supplier or suppliers having regard to a range of criteria according to an embodiment of the present invention.

Because Erickson does not explicitly disclose supplier selection criteria generating means, etc, the Examiner sought to combine Erickson with Giovannoli. Although claims 1 and 14 of the present application require that there be facility for storing a master list of items, each item representing a product or service, this feature is conspicuously absent in Giovannoli. Indeed, in column 1, lines 42 to 60, Giovannoli goes into detail as to why Giovannoli does not include such a master list. Giovannoli appears to be at pains to avoid the need for a master list.

Not only do certain embodiments of the present invention require the storage of a master list of items, some embodiments also require storage of supplier details and purchaser details. Giovannoli, on the other hand, appears to be based on more of a broadcast system. Purchasers, who do not have their details already stored on the system, request quotations. The quotation requests are then broadcast under the system of Giovannoli to prospective sellers. The seller's responses are then processed under the system of Giovannoli back to the prospective buyers. Giovannoli, column 2, lines 35 to 51. Under the system of Giovannoli, the approval of a buyer appears to be required after the quotation has been submitted and before the order has been placed. For certain embodiments of the present invention, on the other hand, the trade takes place between suppliers and purchasers whose details are already stored, according to a predetermined set of supplier selection criteria. In some embodiments, there is also facility for the suppliers available to the purchaser to be predetermined.

Additionally, the Examiner referred to various passages in Giovannoli to support the assertion as to disclosure by Giovannoli of supplier selection criteria and supplier selection criteria generating means recited in one or more of pending claims.

With respect, Applicants do not agree that Giovannoli discloses the various features referred to by the Examiner. Applicants would like to point out that, on an overall view, the system of Giovannoli appear to deal with requests for quotations and not for processing of orders. Certain embodiments of the present invention can provide both. Even more importantly, with both Giovannoli and Erickson the systems appear to be essentially a communications network between suppliers and purchasers. While filtering can take place in Giovannoli in relation to suppliers, neither Giovannoli nor Erickson has the capacity to match a

purchaser with the most appropriate supplier, without the need for any communication between the purchaser and the supplier. Both Giovannoli and Erickson appear to require broadcasting of a request from a buyer to a group of suppliers, followed by independent communication between the parties. Some embodiments of the present invention avoid the need for this and is clearly distinguishable from Giovannoli and Erickson, separately or combined.

Accordingly, claims 1-27 are asserted to be allowable for at least the above reasons.

### **Claim Rejections under 35 U.S.C. § 102**

Claims 28 and 29 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent No. 6,014,644 (Erickson). Applicants respectfully traverse all the Examiner's rejections. To expedite prosecution of the above identified application, Applicants request amendments of claims 28 and 29 to recite a master list of items, each item representing a product or service. Accordingly, claims 28 and 29 are asserted to be allowable for at least the above reasons.

### **Specification**

The Examiner objected to the disclosure because of z-shaped line found on page 17. In response, Applicants have checked the disclosure but have not found any z-shaped line on page 17. Instead, Applicants found a z-shaped line on page 15. Hence Applicants have removed the z-shaped line from page 15 and submitted a replacement sheet for page 15.

### **CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

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Respectfully submitted,



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